

## **REMARKS**

### **Objection to Priority**

The Office Action at page 4 states that Applicants cannot rely on the foreign priority papers to overcome the outstanding rejections because a translation of said papers has not been made of record in accordance with 37 CFR 1.55.

As requested by the Office, Applicants plan to submit English translations of the two priority documents, P2000-237902 (August 7, 2000) and P2000-265510 (September 1, 2000) within the very near future.

### **Rejections of Claims based on Miyagawa or JP'811**

The Office has rejected claim 2 as allegedly anticipated by Miyagawa *et al.* (Miyagawa) or Japanese Patent 2000-256811 (JP '811). The office also has rejected claims 1, 3 and 4 as allegedly obvious over Miyagawa or JP '811.

As stated above, upon submission of the English translation of the two priority documents, the present application is entitled to the priority dates, which are August 7, 2000 and September 1, 2000, respectively. JP '811 was published on September 19, 2000, which is after the later of the two priority dates. Therefore, JP'811 does not qualify as prior art against the claimed invention.

As for Miyagawa, the Office appears to misunderstand that Miyagawa was published 1999, which is more than one (1) year before the priority dates. As verified

by the accompanying declaration generated by one of the authors of Miyagawa, however, Miyagawa was actually published on January 18, 2000, not in 1999. That is, although Miyagawa is referred to as "Study report 1999 made by Yamanashi-ken Kogyo Gijutsu Center," its actual publication did not occur until January 18, 2000, which is within one year prior to the priority dates of the present application. Accordingly, given the correct and actual publication date, Miyagawa is not prior art under 35 USC §102(b).

Furthermore, Applicants respectfully submit that the amorphous precious metal alloy disclosed in Miyagawa is a description of Applicants' own invention, and thus Miyagawa does not qualify as prior art at all.

The accompanying Rule 132 declaration signed by Applicants clearly substantiates that (1) Applicants were employed at Tanaka Kikinzoku Kogyo K.K. ("Tanaka"); (2) the claimed invention was assigned to Tanaka under the employment agreement; and (3) Tanaka, an employer of Applicants, manufactured the amorphous precious metal alloy based on the claimed invention and supplied to Yamanashi-ken Kogyo Gijutsu Center ("Yamanashi-ken"). As shown in Miyagawa, Yamanashi-ken is the company where the experiment disclosed in Miyagawa was conducted using such alloy.

More specifically, Exhibit A clearly shows that the alloy described in Miyagawa, which is based on the rejection, was manufactured by Tanaka. Exhibit B is evidence of showing that Yamanashi-ken received the alloy that was supplied by Tanaka.

The above facts are further substantiated by the accompanying Rule 132

declaration signed by one of co-authors of Miyagawa, Mr. Sin-ichi Nakayama. In his declaration, Mr. Nakayama confirms that the employer of co-authors of Miyagawa, Yamanashi-ken, obtained the alloy described in Miyagawa from Tanaka for their experiment. Thus, he verifies that the alloy described in Miyagawa is a description of work done by Tanaka.

The facts provided and verified by Applicants and an author of Miyagawa sufficiently prove that the alloy described in Table 1 of Miyagawa is a description of Applicants' own invention, which removes Miyagawa from prior art against the claimed invention.

Accordingly, Applicants respectfully request withdrawal of all the rejections based on either Miyagawa or JP'811.

**Rejections of Claims based on EP'151**

The Office has rejected claims 2 and 4 as allegedly obvious over EP 801151 (EP '151). In rejecting claim 2, while admitting that samples 1 to 7 disclosed in EP '151 do not contain Ni, the examiner asserts that the open-ended term "comprising" in claims 2 and 4 does not exclude additional and unrecited elements such as Ni from the claimed composition. Furthermore, relying on Wilson et al., 153 USPQ 740 (1967), the examiner alleges that the omission of Ni with the consequent loss of its function would not be patentable distinction.

At the outset, Applicants would like to direct the examiner's attention to the

amended claim 2, which is directed to a precious metal-based amorphous alloy consisting of a Pt-Pd-Cu-P based structure.

As clearly stated at pages 1 and 4 in the specification, the present invention is directed to a precious metal-based amorphous alloy that is free of nickel to avoid an adverse effect on human body. Instead of using Ni, the present invention uses selected metals in a specific range of amounts to impart the capability of forming an amorphous structure to the alloy composition. The test data shown in Table 2 support that the present invention maintains the desired capability of forming an amorphous structure without using Ni.

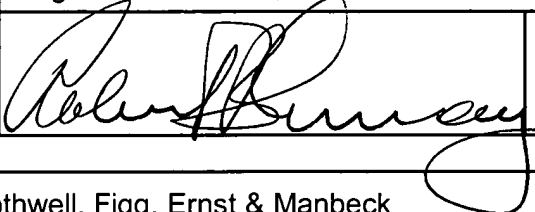
In contrast, Ni is an essential element in the precious metal-based amorphous alloy in EP '151 for amorphous formation. EP '151 specifically states that a proportion of Cu to Ni in its alloying composition contributes to the main advantage of the invention in substantial improvement of amorphous formation capability. (See, at page 3, lines 46-48 and page 4, lines 24-32). According to EP '151, when a proportion of Cu to Ni is less than 1, the melting point of the alloy does not decrease sufficiently so as to be able to improve its amorphous formation. There is nothing in EP '151 that would motivate a skilled person to provide a precious metal-based amorphous alloy that does not include Ni. Rather, EP'151 teaches away from a precious metal-based amorphous alloy without Ni. Therefore, considering the significance of the absence of Ni, together with a teaching-away description of EP'151, the rationale of the rejection based on Wilson *et al.* is also inapplicable to the present case.

In addition, with respect to the rejection of claim 4, as the examiner admits, EP '151 does not teach or suggest the cooling rate recited in claim 4. To establish a *prima facie* case of obviousness, the Office must provide a prior art reference that teaches or suggests all the claim limitations. The Office cannot meet this requirement by simply assuming that such a limitation can be expected from the prior art.

Therefore, the Office fails to establish a *prima facie* case of obviousness in rejecting claims 2 and 4. Accordingly, Applicants respectfully request that the Office withdraw and reconsider the obviousness rejection.

In view of the above amendments and remarks, it is believed that the claims satisfy the requirements of the patent statutes. Reconsideration of the instant application, withdrawal of all rejections and early notice of allowance are requested. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

In the event that this paper is not timely filled, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

RESPECTFULLY SUBMITTED,					
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